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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/706,299	11/11/2003	Assaf Govari	U 014946-4	5768

7590

02/09/2006

Mr. Peter Galloway  
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EXAMINER

VRETTAKOS, PETER J

ART UNIT

PAPER NUMBER

3739

DATE MAILED: 02/09/2006

Please find below and/or attached an Office communication concerning this application or proceeding.

<b>Office Action Summary</b>	Application No.	Applicant(s)	
	10/706,299	GOVARI ET AL.	
	Examiner	Art Unit	
	Peter J. Vrettakos	3739	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --  
**Period for Reply**

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

#### Status

- 1) ☒ Responsive to communication(s) filed on 03 January 2005.
- 2a) ☐ This action is FINAL.                      2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

#### Disposition of Claims

- 4) ☒ Claim(s) 1-24 is/are pending in the application.
- 4a) Of the above claim(s) 1-17 is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 18-24 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

#### Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

#### Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All    b) ☐ Some \* c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
  2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

#### Attachment(s)

- |  |   |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892)                        | 4) <input type="checkbox"/> Interview Summary (PTO-413)                     |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948)               | Paper No(s)/Mail Date. _____  |
| 3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| Paper No(s)/Mail Date <u>7-18-05, 4-22-04</u> .  | 6) <input type="checkbox"/> Other: _____                                    |

### **DETAILED ACTION**

The application is published application number: 2005/0101946.

The Applicant is requested to provide (or check for accuracy) at the beginning of the Specification updated status information (serial numbers and patent numbers) of all related applications. The effective filing date of this application is 11-11-03.

Pending claims are 1-24.

Elected (without traverse) claims 18-24 are examined below.

Non-elected / withdrawn claims are 1-17.

### ***Information Disclosure Statement***

The information disclosure statements (IDS) submitted on 7-18-05 and 4-22-04 are in compliance with the provisions of 37 CFR 1.97. Accordingly, the examiner is considering the information disclosure statements.

The references cited in the Search Report 7-18-05 have been considered, but will not be listed on any patent resulting from this application because they were not provided on a separate list in compliance with 37 CFR 1.98(a)(1). In order to have the references printed on such resulting patent, a separate listing, preferably on a PTO/SB/08A and 08B form, must be filed within the set period for reply to this Office action.

***Claim Rejections - 35 USC § 102***

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

Claims 18 and 22-24 are rejected under 35 U.S.C. 102(e) as being anticipated by Walsh et al. (6,802,857).

Independent claim 18 (parentheticals toward Walsh)

Walsh discloses a system for electrically isolating a cardiac chamber, comprising:  
a resonant circuit (18, col. 4:14) having a resonant frequency adapted for introduction into an operative position in a pulmonary vein (anticipated by language toward a “vessel” in col. 4:1-3; also note that this is intended use language) of a subject proximate an ostium of said pulmonary vein (intended use language);

a catheter (col. 1:44-48) adapted to carry said resonant circuit into said operative position in said pulmonary vein;

a stent (10) dimensioned for circumferential engagement with an inner wall of said pulmonary vein (intended use language) to define a circumferential region (depicted in figure 8, element 46 is the vessel, the RF field is 36) of contact between said stent (10) and said pulmonary vein (intended use language), wherein a principal axis of said stent is substantially aligned coaxially (depicted in figure 8, element 46 is the vessel, the RF field is 36) with said pulmonary vein, said resonant circuit being incorporated in said stent (incorporation disclosed at least once, see col. 4:22-24); and

a generator (col. 5:65 through col. 6:6; col. 1:8-10) disposed external to said subject for generating an electromagnetic field that has a frequency substantially equal to said resonant frequency of said resonant circuit, said electromagnetic field operatively including said resonant circuit and causing said resonant circuit to re-radiate electromagnetic energy so as to ablate (col. 5:50-65) intramural target tissue in said pulmonary vein.

Note: a recitation of the intended use of the claimed invention must result in a structural difference between the claimed invention and the prior art in order to patentably distinguish the claimed invention from the prior art. If the prior art structure is **capable** of performing the intended use, then it meets the claim.

Art Unit: 3739

Dependent claims

22. The system according to claim 18, wherein said stent is constructed of an alloy having a shape memory (col. 4:4-6, "nitinol").

23. The system according to claim 18, wherein said stent is constructed of a biodegradable material (col. 4:4-6, "nitinol").

24. The system according to claim 18, further comprising: a localizing subsystem for tracking a position and orientation of said catheter, comprising: a plurality of localizing field generators disposed external to said subject; a position sensor on said catheter that is responsive to localizing electromagnetic fields produced by said localizing field generators; and a receiver responsive to an output of said position sensor.

***Claim Rejections - 35 USC § 103***

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

Claims 19-21 are rejected under 35 U.S.C. 103(a) as being unpatentable over Walsh (6,802,857) in view of Spillman, Jr. et al. (6,206,835).

Walsh is silent regarding a control circuit and physiological sensors.

However, in an analogous device/method (see the stent 32 in figure 6a), Spillman discloses a sensor (68) for monitoring electrophysiologic cardiac properties (blood pressure, col. 7:32) of said subject for determining if a predefined end point has been reached.

20. The combination of the two patents suggest predefined end point comprises confirmation of a conduction block at said target tissue (intended use language). Also note that an abrupt change in sensed blood pressure (blood pressure, col. 7:32) in theory could **capably** provide confirmation of a conduction block.

21. The combination of the two patents suggest a plurality of capacitors (C1, C2 in figure 5a in Walsh) in said resonant circuit; and a **control circuit (60 in Spillman figure 3)** for automatically selecting one of said capacitors responsively to a frequency of said electromagnetic field to so as to conform said resonant frequency of said resonant circuit with said frequency of said electromagnetic field.

The motivation to combine the patents is to monitor the condition of the implant/stent as allowed by the Spillman stent depicted in figure 6a and is found in Spillman col. 1:22-24.

Therefore, at the time of the invention in would have been obvious to one of ordinary skill in the art to modify Walsh in view of Spillman by including feedback and position sensors. Again, the motivation to combine the patents is to monitor the condition of the implant/stent and is found in Spillman col. 1:22-24.

### ***Conclusion***

The prior art made of record and not relied upon is considered pertinent to applicant's disclosure. Melzer et al. (6,280,385).

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Peter J. Vrettakos whose telephone number is 571-272-4775. The examiner can normally be reached on M-F 9-6.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Linda C. Dvorak can be reached on 571-272-4764. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).



Application/Control Number: 10/706,299  
Art Unit: 3739

Page 8

Pete Vrettakos  
February 2, 2006

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*Michael Peffley*  
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PRIMARY EXAMINER